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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/066,453

01/31/2002

Srinivas Gutta

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10/19/2006

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/066,453	<b>Applicant(s)</b> GUTTA ET AL.	
	<b>Examiner</b> Justin E. Shepard	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/3/06.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Although the same prior art will be used, the rejections will be modified to reject the newly added limitations.

### ***Drawings***

The drawings are objected to because are multiple figure 4s. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings received on 1/31/02 are correct, while the drawings received 5/28/02 contain two figure 4s.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 6, 7, 8, 12, 14, 15, 16, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berenson in view of Finseth.

Referring to claim 1, Berenson discloses a method for customizing a subscription plan, the method comprising the steps of: receiving a plurality of programs from a plurality of channels (page 2, paragraph 31, lines 9-11; page 6, paragraph 65, lines 1-3); monitoring each of said plurality of programs watched by a user to generate a user profile indicative of a particular program being watched by said user (page 2, paragraph 33, lines 13-23); recommending a plurality of subscription plans based on said user profile (figure 7; page 6, column 1, lines 1-4); selecting at least one of the plurality of subscription plans (page 6, paragraph 64, lines 3-8; Note: tuning to a program in the recommend subscription plan is interpreted as being equivalent to selecting a

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subscription plan); and selecting at least one program associated with one of the select at least one subscription plan (page 6, paragraph 64, lines 3-8).

Berenson does not disclose a method wherein the monitoring of the programs being watched includes the frequency of the programs being watched.

Finseth discloses a method wherein the monitoring of the programs being watched includes the frequency of the programs being watched (column 14, lines 13-16).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the frequency monitoring taught by Finseth in the subscription plan creating method disclosed by Berenson. The motivation would have been to organize the viewing habits based on the program popularity (Finseth: column 14, line 16).

Claim 14 is rejected on the same grounds as claim 1.

Referring to claim 2, Berenson discloses a method of claim 1, further comprising the step of selecting at least one channel associated with one of the select at least one subscription plans interactively in response to a user's input (page 3, paragraph 42, lines 1-4 and 7-10).

Claims 15 and 16 are rejected on the same grounds as claim 2.

Referring to claim 4, Berenson does not disclose a method of claim 1, further comprising the step of displaying said selected program for viewing.

Finseth discloses a method of claim 1, further comprising the step of displaying said selected program for viewing (column 7, lines 64-67).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the television display taught by Finseth in the method disclosed by Berenson. The motivation would have been to provide the program to the user.

Claims 12 and 18 are rejected on the same grounds as claim 4.

Referring to claim 5, Berenson discloses a method of claim 1, further comprising the step of updating the content of said user profile to reflect said user's changing preference (page 8, paragraph 113, lines 6-8).

Claim 19 is rejected on the same grounds as claim 5.

Referring to claim 6, Berenson discloses a method of claim 1, wherein the step of monitoring each of said plurality of programs watched by said user further comprises the step of classifying the content of said plurality of programs according to predetermined criteria (page 6, paragraph 65, lines 4-7).

Claim 20 is rejected on the same grounds as claim 6.

Referring to claim 7, Berenson discloses a method of claim 6, wherein said classification of each of said plurality of programs watched is performed according to an electronic program guide (EPG) (figure 9).

Referring to claim 8, Berenson discloses a method of claim 1, wherein said step of the selection of programs is performed interactively in response to said user's input (page 3, paragraph 36, lines 1-3).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9, 11, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Berenson.

Referring to claim 9, Berenson discloses a method for customizing a subscription plan for a viewer, the method comprising the steps of: generating at least one user profile indicating said viewer's preference for a particular program (page 2, paragraph 33, lines 13-23); comparing said user profile with incoming programs from a plurality of channels to determine a match (page 6, column 1, lines 1-4); if there is match, recommending said matched programs to said viewer for future subscription (figure 7); and selecting at least one matched program, associated with a future subscription, for viewing at a particular time (page 6, paragraph 64, lines 3-8).

Claim 11 is rejected on the same grounds as claim 8.

Claim 13 is rejected on the same grounds as claim 5.

Claims 3, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berenson in view of Finseth as applied to the claims above, and further in view of Ottesen.

Referring to claim 3, Berenson and Finseth do not disclose a method of claim 1, further comprising the steps of storing said selected program in a storage medium for subsequent replay, and charging said user only for the subsequently viewed program.

Ottesen discloses a method of claim 1, further comprising the steps of storing said selected program in a storage medium for subsequent replay, and charging said user only for the subsequently viewed program (column 12, lines 14-31).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the storage playback charging taught by Ottesen to the method disclosed by Berenson and Finseth. The motivation would have been to allow for the cable distributor to prevent pirating by having the STB call back whenever the recorded media is played.

Claims 10 and 17 are rejected on the same grounds as claim 3.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS



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